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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,513	02/01/2002	Ramarao V. Gundlapalli	1671-0213 (DEP-671)	1804

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09/18/2003

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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 09/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/061,513

Applicant(s)

GUNDLAPALLI ET AL.

Examiner

Pedro Philogene

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,355,045. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between these two sets of claims is that in the application the bushing receiving portion is omitted. Clearly applicant is attempting to obtain broader coverage in the claims of the application.

It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Thus, the controlling fact is that patent protection for the method and apparatus for surgically preparing a tibia for implantation of a prosthetic implant component, which has an offset stem, fully disclosed in the and covered by the claims of the patent would be extended by the allowance of the claims in the application; and, nothing prevented

application from presenting the claims in the application for examination during the prosecution of the issued patent.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wildgoose et al. (5,690,636) in view of Steele et al. (5,312,411).

With respect to claim 1, Wildgoose et al disclose a surgical assembly for preparing a tibia for implantation of a prosthetic implant, comprising: a tray trial (50) adapted to be secured to a proximal end of the tibia and defining a plate opening (55) the plate opening having a center point; and a first guide (61) adapted to be secured to the trial tray.

It is noted that Wildgoose et al did not teach of a guide wherein the first guide defines at least a first bore and a second bore therethrough, each of the first and second bores having a center point arranged to be offset from the center point of the plate opening of the tray trial when the first guide is secured to the tray trial; as claimed by applicant. However, in a similar art, Steele et al evidences the use of a trial guide (FIG.4) with first and second bores offset from the center to create overlapping cuts in the selected area.

Therefore, given the teaching of Steele et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the overlapping bore of Steele et al in the device of Wildgoose et al to create overlapping cuts in the selected tibia plateau.

With respect to claims 2-10, the above combination of references teaches all the limitations, as set forth in Wildgoose et al., columns 3-7, lines 1-67, and as best seen in FIGS. 1-6; and, Steele et al., columns 3-5, lines 1-67, and as best seen in FIGS. 1-8.

With respect to claims 11-18, the method steps, as set forth, would have been obviously carried out in the operation of the device, as set forth above.

With respect to claim 19, Wildgoose et al., disclose a guide for use with a tray trial (50) for implantation of a prosthetic implant, in which the tray trial defines a plate opening (55) therethrough having a center point, the guide device comprising a guide body (61) defining a guide opening (68), means (64,69) for securing the guide body to the tray.

It is noted that Wildgoose et al did not teach of a guide opening including at least a first bore and a second bore therethrough, each of the first and second bores having a center point arranged to be offset from the center point of the plate opening of the tray trial when the first guide is secured to the tray trial; as claimed by applicant. However, in a similar art, Steele et al evidences the use of a trial guide (FIG.4) with first and second bores offset from the center to create overlapping cuts in the selected area.

Therefore, given the teaching of Steele et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the

overlapping bore of Steele et al in the device of Wildgoose et al to create overlapping cuts in the selected tibia plateau.

With respect to claim 20, the above combination of references teaches all the limitations, as best seen in the FIGS.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,733,290	03-1998	McCue et al.
5,788,701	08-1998	McCue
5,976,147	11-1999	LaSalle et al.
6,159,216	12-2000	Burkinshaw et al.
6,520,966	02-2003	Kohler et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
PEDRO PHILOGÈNE  
PRIMARY EXAMINER

Pedro Philogene  
September 12, 2003